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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,571	01/17/2002	Mark W. Minne'	10003994-1	5821

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P.O. Box 272400  
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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT	PAPER NUMBER
2835	

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/051,571	MINNE, MARK W.
	Examiner	Art Unit
	Michael V Datskovskiy	2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 17 October 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 17 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see Response, filed 10/17/2003, with respect to the rejection(s) of claim(s) 1-3, 6, 8-9, 13-15, 16-20 and 22 under 35 USC § 102, and claims 4, 7, 10-12 and 21 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly discovered reference - US Patent 6,295,031 by Wallace et al.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-6, 9-10, 11-17, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallace et al.

Wallace et al teach a form factor card - a memory card, Figs.1-12, for use with a host electronic device, the memory card comprising: an adapter (connector) 14 region for mechanically and electrically interfacing with the host electronic device; a data storage device having a plurality of memory modules (col.3, lines 18-41); an on-card intelligent controller (col.11, line 64 through col.12, line 9); and a plurality of indicating light emitting diodes 30 viewable by a host electronic device user wherein the on-card intelligent controller controls the indicating on or off status to thereby communicated to the user a plurality of operational statuses of the memory card. Wallace et al teach furthermore: said card being an input/output radio card; said indicating lights having a plurality of colors (col.8, lines 23-32); said controller controls said indicating lights 30 for a finite period of time equal the time of a certain operation mode of the card. Regarding to the claims 11 and 12: It is inherent by radio/memory card provided with antenna to be capable of receiving pager or fax/modem communications. Regarding to the claim 22: The method steps are inherently necessitated by the device structure, as Wallace et al disclose it.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 7, 10-12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al.

Wallace et al teach all the limitations of the claims except said lights indicating a failure mode (claim 7), proper interfacing of said card with a host computer (claim 8), status of said card reaching (approaching) full memory capacity (claim 19) or has already reached said full memory capacity (claim 20). Wallace et al teach an IC card comprising a light emitting diodes 30 indicating in addition to a status of a radio transmission signals also a plurality of others unidentified statuses of the card. It would have been obvious to one skilled in the art at the time invention was made to employ an IC card having a light emitting diode indicating among others a status of the failure of the card, proper interfacing of said card with a host computer, status of said card reaching (approaching) full memory capacity or having already reached said full memory capacity in order to diversify indicating ability of the device and improve it ergonomically, since applicant has not disclosed either particular structures of said different modes of indicating lights of the card, or that the type of the indicating light card solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with different types of indicating lights of the IC cards.

7. Examiner requests applicant to send another copy of Exhibits A and B, included with the last response.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Datskovsky whose telephone number is (703) 306-4535. The examiner can normally be reached on Mn - Fry 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren E. Schuberg can be reached on (703) 308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Primary Examiner

Michael Datskovsky



November 17, 2003